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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2443

NOTIFICATION DATE	DELIVERY MODE
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12/23/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/976,301	Applicant(s) GROVE, STEVE	
	Examiner DAVID E. ENGLAND	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 - 8, 10 - 13, 15 - 19, 21 - 24, 26 - 30, 32 - 35, 37 - 41 and 43 - 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/29/2008, 10/02/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1, 2, 4 - 8, 10 - 13, 15 - 19, 21 - 24, 26 - 30, 32 - 35, 37 - 41 and 43 - 48 .

DETAILED ACTION

1. Claims 1, 2, 4 – 8, 10 – 13, 15 – 19, 21 – 24, 26 – 30, 32 – 35, 37 – 41 and 43 – 48 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/29/2008 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 09/29/2008 and 10/02/2008 was filed after the mailing date of the Pre Brief Conference Request on 06/16/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1, 2, 4 – 8, 10 – 13, 15 – 19, 21 – 24, 26 – 30, 32 – 35, 37 – 41 and 43 – 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1, 12, 23 and 34 recite the limitation "said second entity". There is insufficient antecedent basis for this limitation in the claim.

7. All other claims are rejected for their dependency on claims 1, 12, 23 and 34, most of which state "said second entity". Applicant is asked to amend the independent claims to overcome this rejection.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 4, 5, 10 – 12, 15, 16, 21 – 23, 26, 27, 32 – 34, 37, 38 and 43 – 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanagan et al. (5966685) (hereinafter Flanagan) in view of Gastaldo et al. (6473729), (hereinafter Gastaldo).**

10. Referencing claim 1, as closely interpreted by the Examiner, Flanagan teaches a method to facilitate translation of communications between entities over a network, said method comprising:

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11. responsive to receipt of a first language construct, identifying a translated language construct corresponding to said first language construct, (e.g. col. 4, lines 21 – 37 & col. 5, line 45 – 36), said identifying further comprises:

12. retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity, (e.g. col. 4, lines 21 – 37 & col. 5, line 45 – 36); and

13. communicating said translated language construct to said second entity as a second transmission over said network, (e.g. col. 4, lines 21 – 37 & col. 5, line 45 – 36). Although, Flanagan could teach one word questions or phrases, multiword phrases are not specifically stated as being predetermined.

14. Flanagan does not specifically teach communicating a plurality of predetermined language constructs including a first language construct to a first entity;

15. responsive to receipt of a selection by said first entity of said first language construct of said plurality of predetermined language constructs, identifying a translated language construct corresponding to said first language construct, said identifying further comprises:

16. retrieving said translated language construct from a table based on said entity information and said first language construct.

17. Gastaldo teaches communicating a plurality of predetermined language constructs to a first entity, (e.g., Figures 5 – 7 and supporting text, col. 5, line 35 – col. 6, line 35 et seq.);

18. responsive to receipt of a selection by said first entity of said first language construct of said plurality of predetermined language constructs, identifying a translated language construct corresponding to said first language construct, (e.g., Figures 5 – 7 and supporting text, col. 5, line 35 – col. 6, line 35 et seq.), said identifying further comprises:

19. retrieving said translated language construct from a table based on said entity information and said first language construct, (e.g., Figures 5 – 7 and supporting text, col. 5, line 35 – col. 6, line 35 et seq.).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gastaldo with Flanagan because utilizing predetermined phrases in a database situation could aid in a faster translation since no real “translation” is occurring, i.e. verbs, nouns and other grammatical instances do not need to be considered all that is needed is the relational IDs between the two fields.

21. As to claim 4, as closely interpreted by the Examiner, Flanagan teaches said entity information further comprises a language preference of said second entity, (e.g. col. 4, lines 21 – 37 & col. 5, line 45 – 36).

22. Referencing claim 5, as closely interpreted by the Examiner, Flanagan teaches said predetermined setup is requested by said first entity in an electronic commerce transaction over said network, (e.g. col. 4, lines 21 – 37 & col. 5, line 45 – 36). Although Flanagan and Gastaldo do not explicitly teach the use of a question, it is well known in the art and would be obvious to one of ordinary skill in the art that the claimed invention is only linking fields in a database and it would make no difference if what is being “translated” is a question or a statement.

23. Referencing claim 10, as closely interpreted by the Examiner, Flanagan teaches a network-based transaction facility, (e.g. col. 4, lines 21 – 37 & col. 5, line 45 – 36).

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24. Flanagan does not specifically teach storing said plurality of predetermined language constructs and an associated plurality of translated language constructs so as to define a correspondence between each language construct of said plurality of predetermined language constructs and at least one associated translated language construct of said plurality of translated language constructs. Gastaldo teaches storing said plurality of predetermined language constructs and an associated plurality of translated language constructs so as to define a correspondence between each language construct of said plurality of predetermined language constructs and at least one associated translated language construct of said plurality of translated language constructs, (e.g., Figures 5 – 7 and supporting text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gastaldo with Flanagan because of similar reasons stated above.

25. Referencing claim 11, as closely interpreted by the Examiner, Flanagan does not specifically teach teaches said storing is so as to define a correspondence between a set of said plurality of translated language constructs, each translated language construct of said set comprising a predetermined translation of a common underlying language construct.

26. Gastaldo teaches said storing is so as to define a correspondence between a set of said plurality of translated language constructs, each translated language construct of said set comprising a predetermined translation of a common underlying language construct, (e.g., Figures 5 – 7 and supporting text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gastaldo with Flanagan because of similar reasons stated above.

27. Claims 12, 15, 16, 21 – 23, 26, 27, 32 – 34, 37, 38 and 43 – 45 are rejected for similar reasons stated above.

28. Claims 2, 6, 7, 13, 17, 18, 24, 28, 29, 35, 39, 40 and 46 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanagan and Gastaldo in further view of Scanlan (6857022).

29. Referencing claim 2, as closely interpreted by the Examiner, Flanagan and Gastaldo do not specifically teach communicating a plurality of interactive fields to said second entity in said second transmission to allow said second entity to interact with at least one interactive field of said plurality of interactive fields in response to said translated language construct. Scanlan teaches communicating a plurality of interactive fields to said second entity in said second transmission to allow said second entity to interact with at least one interactive field of said plurality of interactive fields in response to said translated language construct, (e.g. col. 3, line 63 – col. 4, line 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Scanlan with the combine inventions of Flanagan and Gastaldo with because utilizing a drop down menu allows the user to not type information into the system and possibly mistyping information, causing errors in the system.

30. Referencing claim 6, as closely interpreted by the Examiner, Flanagan and Gastaldo do not specifically teach said first transmission is a Hyper Text Markup Language (HTTP) message.

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Scanlan teaches said first transmission is a Hyper Text Markup Language (HT'IP) message, (e.g., col. 1, lines 17 – 38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Scanlan with the combine inventions of Flanagan and Gastaldo because it would be obvious that in a communication with a web server that the first communication would be a type of HTTP message.

31. As to claim 7, as closely interpreted by the Examiner, Flanagan and Gastaldo do not specifically teach said second transmission is an electronic mail message. Scanlan teaches said second transmission is an electronic mail message, (e.g. col. 6, lines 31 – 65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Scanlan with the combine inventions of Flanagan and Gastaldo because of similar reasons stated above, also utilizing email gives users the ability to communicate with other users across a network.

32. As per claim 46, as closely interpreted by the Examiner, Flanagan teaches all that is similar to claim 46 as taught in claims 1 and 45 above. Furthermore, Scanlan teaches interactive fields as taught above. Similarly reasons for combining are also found above.

33. As per claim 47, as closely interpreted by the Examiner, Flanagan does not specifically teach said plurality of interactive fields includes a first interactive field, wherein said first interactive field includes a drop down list that contains a second plurality of predetermined language constructs that respectively translated into a second language based on a language preference of said second entity.

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34. Gastaldo teaches said plurality of interactive fields includes a first interactive field, wherein said first interactive field includes a drop down list that contains a second plurality of predetermined language constructs that respectively translated into a second language based on a language preference, (e.g., Figures 5 – 7 and supporting text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gastaldo with Flanagan because of similar reasons stated above.

35. Scanlan teaches of said second entity that will receive the email with the translated language, (e.g. col. 6, lines 31 – 65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Scanlan with the combine inventions of Flanagan and Gastaldo because of similar reasons stated above.

36. As per claim 48, as closely interpreted by the Examiner, Flanagan and Gastaldo do not specifically teach receiving a reply message from said second entity that includes a selection of the said second entity from said first interactive field, said selection of the second entity including a response from said second entity to said predetermined question that is asked by said first entity. Scanlan teaches receiving a reply message from said second entity that includes a selection of the said second entity from said first interactive field, said selection of the second entity including a response from said second entity to said predetermined question that is asked by said first entity, (e.g. col. 6, lines 31 – 65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Scanlan with the combine inventions of Flanagan and Gastaldo because of similar reasons stated above.

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37. Claims 13, 17, 18, 24, 28, 29, 35, 39 and 40 are rejected for similar reasons as stated above.

38. Claims 8, 19, 30 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanagan and Gastaldo in view of Christy (6301554).

39. As to claim 8, as closely interpreted by the Examiner, Flanagan and Gastaldo do not specifically teach said identifier of said second entity is an electronic mail address of said second entity. Christy teaches said identifier of said second entity is an electronic mail address of said second entity, (e.g. col. 2, line 47 – col. 3, line 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Christy with the combine inventions of Flanagan and Appleby because of similar reasons stated above. Furthermore, in an email system, in order to send a message, one must have a type of identifier, “an address”, or the email cannot be sent.

40. Claims 19, 30 and 41 are rejected for similar reasons as stated above.

Response to Arguments

41. Applicant's arguments filed 09/29/2008 have been fully considered but they are not persuasive.

42. **In the Remarks**, Applicant argues in substance that Flanagan does not teach, "retrieving entity information relating to said second entity based on an identifier of said second entity

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selected by said first entity and retrieving said translated language construct from a table based on said entity information and said first language construct.” Emphasis on a first entity to select a language construct and an identifier of a second entity, which Applicant states Flanagan does not teach both.

43. As to this Remark, Applicant is asked to view the newly rejected claims, for Flanagan is only utilized to select entity information relating to said second entity based on an identifier. This is clear since it is well known in the networking arts that in order to communicate with another entity, one must have an identifier of sorts to do such, as seen in the cited areas of Flanagan.

44. Applicant further states that Gastaldo does not teach both steps.

45. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

46. Gastaldo is utilized to teach the language construct table as stated above in combination with Flanagan.

47. **In the Remarks**, Applicant argues in substance that Gastaldo relates to a system for “assisting a translator to get the right translation for any phrase” and that the Flanagan emphasizes the benefits of translating without “human intervention” and therefore there is no motivation to combine.

48. As to this Remark, in response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

49. Furthermore, if Flanagan does not need "human intervention" than the combination of Flanagan and Gastaldo would be an improvement on Gastaldo's invention in that one does not need "human intervention".

50. **In the Remarks**, Applicant argues in substance that Scanlan does not teach, "retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity and retrieving said translated language construct from a table based on said entity information and said first language construct."

51. As to this Remark, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. ENGLAND whose telephone number is (571)272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. England
Examiner
Art Unit 2443

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